

over Figs. 1-6 of U.S. D454,910 in view of SMALL (U.S. Patent No. 5,513,117) or STICH (U.S. Patent No. 5,760,381) or KIM (U.S. Patent No. 6,269,158) or FONSECA (U.S. Patent No. 5,640,447) or FONSECA (U.S. Patent No. 5,629,977) or MICHELS et al. (D310,381); rejected claims 7-10, 12, 16-20, 22, and 23 under 35 U.S.C. § 102(b) as anticipated by STICH et al.; rejected claims 7-10, 12-22, and 24 under 35 U.S.C. § 102(e) as anticipated by KLURE (U.S. Patent No. 6,328,341); rejected claims 7-11, 15, and 22 under 35 U.S.C. § 102(e) as anticipated by KIM; rejected claims 1-4, 11, 28, and 29 under 35 U.S.C. § 103(a) as unpatentable over STICH et al.; rejected claims 1-4, 6, 11, 28, and 29 under 35 U.S.C. § 103(a) as unpatentable over KLURE; rejected claims 1-4, 11, 28, and 29 under 35 U.S.C. § 103(a) as unpatentable over KIM; rejected claims 1-4 and 6 under 35 U.S.C. § 103(a) as unpatentable over HOLSTROM (U.S. Patent No. 5,570,081) in view of STICH et al. or KIM or KLURE or TASKETT (U.S. Patent No. 5,684,291); rejected claims 13, 14, and 21 under 35 U.S.C. § 103(a) as unpatentable over KIM or STICH et al. in view of FONSECA ('977); rejected claims 15 and 25-27 under 35 U.S.C. § 103(a) as unpatentable over KIM or KLURE or STICH et al. in view of FONSECA ('477) or SMALL or vice versa SMALL in view of KLURE or KIM or STICH et al.; and rejected claim 30 under 35 U.S.C. § 103(a) as unpatentable over KIM or KLURE or STICH et al. in view of RAMING (U.S. Patent No. 6,186,554) or MACWILLIAMS et al. (U.S. Patent No. 6,385,860) or BISHOP (U.S. Patent No. 5,607,738). Applicant respectfully traverses these rejections.

At the outset, Applicant notes that the Office Action contains three separate § 102 rejections and twenty-seven separate § 103 rejections. The Examiner is respectfully

reminded that undue multiplication of references should be avoided in rejections (M.P.E.P. § 707.07(g)) and that the Examiner is not required to cite all references available - only the best (M.P.E.P. § 904.03). Applicant respectfully requests that only the best references be applied in any subsequent rejections over art, to avoid "add[ing] to the burden and cost of prosecution" (*Id.*).

Applicant also notes that claim 5 was canceled in the Amendment filed March 11, 2002. Therefore, the Examiner's rejection of this claim under the judicially created doctrine of obviousness-type double patenting over Figs. 1-6 of D454,910 is improper. Correction is respectfully requested.

Claims 1-6 and 28-30 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Figs. 1-6 of U.S. D454,910. Applicant respectfully traverses.

The law provides that, in some very rare cases, obviousness-type double patenting may be found between design and utility patents. See *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-940, 220 USPQ 481, 487 (Fed. Cir. 1983). In these cases, a "two-way" test is applicable. See *Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 220 USPQ at 487.

Based on the test articulated in *Carman*, Applicant submits that the Examiner's conclusory statement that "[t]hey are not patentably distinct from each other because the

shown design patent meets the claimed limitations" is insufficient for establishing a *prima facie* case of obviousness-type double patenting.

For at least the foregoing reasons, Applicant requests that the rejection of 1-6 and 28-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Figs. 1-6 of U.S. D454,910 be reconsidered and withdrawn.

Claims 7-27 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Figs. 1-6 of U.S. D454,910 in view of SMALL or STICH et al. or KIM or FONSECA ('447) or FONSECA ('977) or MICHELS et al. Applicant respectfully traverses this rejection.

As set forth above, a "two-way" test is applicable when rejecting a claim in a utility application under obviousness-type double patenting based on a design patent. See Carman, 724 F.2d at 940, 220 USPQ at 487. The Examiner failed to provide the necessary showing articulated in Carman for establishing a *prima facie* case of obviousness-type double patenting.

For at least the foregoing reasons, Applicant requests that the rejection of 7-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Figs. 1-6 of U.S. D454,910 in view of SMALL or STICH et al. or KIM or FONSECA ('447) or FONSECA ('977) or MICHELS et al. be reconsidered and withdrawn.

Claims 7-10, 12, 16-20, 22, and 23 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by STICH et al. Applicant respectfully traverses this rejection.

Claim 7 recites receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. Applicant submits that STICH et al. does not disclose this combination of features.

For example, STICH et al. does not disclose generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion. The Examiner relied on Figs. 1-9 of STICH et al. for allegedly disclosing the multipurpose cards (Office Action, pg. 4). Applicant disagrees with the Examiner's interpretation of the STICH et al. disclosure.

STICH et al. discloses a debit card 11 packaged in a debit card assembly 10, 210, 310, 410 (see Figs. 1-9). The packaging assembly may, as illustrated in Figs. 1, 2, and 4-8, include an opening capable of receiving a hook or tine 35 (col. 5, lines 1-5). Contrary to the Examiner's interpretation, one skilled in the art would appreciate that the packaging assembly 10, 210, 310, 410 of STICH et al. is not part of the debit card 11 and, therefore, cannot be considered part of the recited multipurpose card. Moreover, STICH et al. does not disclose or suggest the debit card 11 having a main portion and a keytag portion. It will be appreciated that the packaging assembly 10, 210, 310, 410 would not be considered a "keytag," as that term is commonly known to one skilled in the art.

Applicant strenuously objects to the Examiner's interpretation of the term keytag as anything containing a hole when that term has specific meaning in the art.

Applicant further submits that STICH et al. does not disclose customizing at least one of the keytag portion and the main portion of each multipurpose card to include personal information. With respect to this feature, the Examiner alleged that "Stich teaches the card could comprises of graphics and indicia" (Office Action, pg. 4). Even if STICH et al. discloses the placement of graphics and indicia on the packaging assembly, STICH et al. does not disclose or even suggest that the debit card or packaging is customized with received personal information.

For at least the foregoing reasons, Applicant submits that claim 7 is not anticipated by STICH et al.

Claims 8-10 and 12 depend from claim 7. Therefore, Applicant submits that these claims are not anticipated by STICH et al. for at least the reasons given above with respect to claim 7.

Claims 16 and 22 recite features similar to those described above with respect to claim 7. Accordingly, Applicant submits that claims 16 and 22 are not anticipated by STICH et al. for reasons similar to those set forth above with respect to claim 7. Claims 17-20 depend from claim 16. Therefore, Applicant submits that claims 17-20 are not anticipated by STICH et al. for at least the reasons given above with respect to claim 16. Claim 23 depends from claim 22. Therefore, Applicant submits that claim 23 is not anticipated by STICH et al. for at least the reasons given above with respect to claim 22.

Claims 7-10, 12-22, and 24 were rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over KLURE. Applicant respectfully traverses this rejection.

With respect to claim 7, KLURE does not disclose generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion. The Examiner relied on Figs. 1-7 of KLURE for allegedly disclosing the multipurpose cards (Office Action, pg. 5). Applicant disagrees with the Examiner's interpretation of the KLURE disclosure.

KLURE discloses that one or more cards 12 can be packaged in an assembly 10 (see Figs. 1-7). The packaging assembly may, as illustrated in Figs. 1-6, include an opening 24 capable of receiving a hook (col. 3, lines 45-47). Contrary to the Examiner's interpretation, one skilled in the art would appreciate that the packaging assembly 10 of KLURE is not part of the card 12 and, therefore, cannot be considered part of the recited multipurpose card. Moreover, KLURE does not disclose or suggest the card 12 having a main portion and a keytag portion. It will be appreciated that the packaging assembly 10 is not a "keytag," as that term is commonly known by those skilled in the art. Therefore, Applicant submits that KLURE does not disclose the recited multipurpose card.

Applicant further submits that KLURE does not disclose customizing at least one of the keytag portion and the main portion of each multipurpose card to include personal information, as also recited in claim 7. The Examiner relied on col. 3, lines 31-33, of KLURE for allegedly disclosing this feature (Office Action, pg. 5). This section of KLURE discloses that the front face of the card 12a can contain "attractive pictorial or

photographic artwork and other information designed to attract purchasers." Applicant submits that KLURE does not disclose or even suggest that the information on the front of the card 12a can be customized, but merely that the front of the card 12a can contain information to attract purchasers.

In the response to arguments section, the Examiner alleged that "Klure teaches a package with a perforations which makes it possible for one to separate a calling card portion from a second portion with a hole through which a key ring can be held. The limitation concerning a key tag portion is met by the rejection based on what's shown in the figs. taught by Klure given the fact that the key tag portion taught by the present invention is a hole within a section of a card package to hold a key ring." Applicant disagrees with the Examiner's allegation.

Claim 7 specifically recites that the multipurpose card includes a main portion and a keytag portion. Contrary to the Examiner's allegation, claim 7 does not recite that the keytag portion is a hole within a section of a card package. Applicant submits that the term "keytag" is well known in the art and that one skilled in the art would readily appreciate that KLURE's packaging 10 is in no way a keytag.

For at least the foregoing reasons, Applicant submits that claim 7 is not anticipated by KLURE.

Claims 8-10 and 12-14 depend from claim 7. Therefore, Applicant submits that these claims are not anticipated by KLURE for at least the reasons given above with respect to claim 7.

Claims 15, 16, and 22 recite features similar to those described above with respect to claim 7. Accordingly, Applicant submits that claims 15, 16, and 22 are not anticipated by KLURE for reasons similar to those set forth above with respect to claim 7. Moreover, these claims are not anticipated by KLURE for reasons of their own.

For example, claim 15 recites, *inter alia*, means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information specified by the user. The Examiner admitted that KLURE does not disclose this feature (Office Action, pg. 13).

A proper rejection under 35 U.S.C. § 102 requires that the reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. 2131. Since, as set forth above, the Examiner admits that KLURE does not disclose means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information specified by the user, Applicant respectfully submits that the rejection of claim 15 under 35 U.S.C. § 102(e) as anticipated by KLURE should be withdrawn.

Claims 17-21 depend from claim 16. Therefore, Applicant submits that these claims are not anticipated by KLURE for at least the reasons given above with respect to claim 16.

Claim 24 depends from claim 22. Therefore, Applicant submits that claim 24 is not anticipated by KLURE for at least the reasons given above with respect to claim 22.

Claims 7-11, 15, and 22 were rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over KIM. Applicant respectfully traverses this rejection.

With respect to claim 7, KIM does not disclose generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion. The Examiner relied on col. 3, lines 36-38, of KIM for allegedly disclosing the keytag portion (Office Action, pg. 7). Applicant respectfully disagrees.

Col. 3, lines 34-38, of KIM discloses that the postcard portion 11 can include a section 14 for hanging the frontal view of the postcard 11. The mere fact that the postcard portion 11 in KIM has an opening that allows the card unit to be hung does not mean that the postcard unit 11 is a keytag. As pointed out repeatedly above, the word "keytag" has specific meaning in the art. One skilled in the art will appreciate that a postcard is not a keytag. Therefore, Applicant submits that KIM does not disclose the recited multipurpose card.

For at least the foregoing reasons, Applicant submits that claim 7 is not anticipated by KIM.

Claims 8-11 depend from claim 7. Therefore, Applicant submits that these claims are not anticipated by KIM for at least the reasons given above with respect to claim 7.

Claims 15 and 22 recite features similar to those described above with respect to claim 7. Accordingly, Applicant submits that claims 15 and 22 are not anticipated by KIM for reasons similar to those set forth above with respect to claim 7. Moreover, these claims are not anticipated by KIM for reasons of their own.

For example, claim 15 recites, *inter alia*, means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information

specified by the user. The Examiner admitted that KIM does not disclose this feature (Office Action, pg. 13).

As set forth above, a proper rejection under 35 U.S.C. § 102 requires that the reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. 2131. Since the Examiner admits that KIM does not disclose means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information specified by the user, Applicant respectfully submits that the rejection of claim 15 under 35 U.S.C. § 102(e) as anticipated by KIM should be withdrawn.

Claims 1-4, 11, 28, and 29 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over STICH et al. Applicant respectfully traverses this rejection.

Claim 1 recites a multipurpose calling card having a calling card portion and a key ring portion, where the key ring portion is separable from the calling card portion, and where the size of the multipurpose calling card is approximately the size of a conventional calling card. Applicant respectfully submits that STICH et al. does not disclose or suggest this combination of features.

For example, Applicant respectfully submits that STICH et al. does not disclose a multipurpose calling card that includes a key ring portion. The Examiner relied on Figs. 1-9 of STICH et al. for allegedly disclosing this feature (Office Action, pg. 8). Applicant submits that these figures do not disclose a multipurpose card that includes a key ring portion.

Figs. 1-9 of STICH et al. disclose the placement of a debit card 11 in packaging 10 that allows the card to be "swiped" while still in the packaging 10 (see, for example, Abstract, lines 1-9). One skilled in the art will appreciate that STICH et al.'s packaging 10 is not part of debit card 11, and thus, is not equivalent to the recited key ring portion.

Even assuming, for the sake of argument, that STICH et al.'s packaging 10 could reasonably be construed to be a part of a multipurpose calling card, Applicant submits that STICH et al.'s packaging 10 would not be considered a key ring portion. The Examiner fails to explain why one skilled in the art would have been motivated to put STICH et al.'s packaging 10 on a key ring. Despite the Examiner's allegations, the mere fact that the packaging 10 includes a hole would not lead one skilled in the art to hang this packaging from a key ring.

Applicant further submits that STICH et al. does not disclose the size of the multipurpose calling card being approximately the size of a conventional calling card. The Examiner admitted that STICH et al. does not disclose this feature and alleged "it would have been obvious to one of ordinary skill in the art and a matter of design choice to customized the multipurpose package or card to any desired size based on cost considerations since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955)" (Office Action, pg. 8). Applicants respectfully disagree.

STICH et al. specifically discloses that each of the panels 22 and 23 of packaging 10 has an area at least 20% larger than the card area and typically at least three times

larger than the card area (col. 4, lines 13-25). STICH et al. does not disclose or suggest that packaging 10 is approximately the size of a conventional calling card. The Examiner's conclusory statement that this feature is merely a "design choice" is unsubstantiated by the disclosure of STICH et al. and insufficient for establishing a *prima facie* case of obviousness.

Moreover, the Examiner's quote of the decision in *In re Rose*, 105 USPQ 237 (CCPA 1995), misses the point since Applicant's claim 1 does not recite the packaging for a multipurpose card being approximately the size of a conventional calling card, but rather that a multipurpose card that includes a calling card portion and a key ring portion is approximately the size of the a conventional calling card.

For at least the foregoing reasons, Applicant submits that claim 1 is patentable over STICH et al.

Since claims 2-4 depend from claim 1, these claims are patentable over STICH et al. for at least the reasons given above with respect to claim 1.

Claim 11 depends from claim 7. Applicant submits that claim 11 is patentable over STICH et al. for at least the reasons given above with respect to claim 7.

Claim 28 recites features similar to those described above with respect to claim 1. Therefore, Applicant submits that claim 28 is patentable over STICH et al. for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed by STICH et al.

For example, claim 28 recites creating a perforation in the card to create a first calling card portion and a second portion. STICH et al. does not disclose or suggest this

feature. The Examiner appears to rely on Figs. 5-7 and col. 4, lines 37-38, of STICH et al. for allegedly disclosing this feature. These sections of STICH et al. merely disclose that packaging 10 may be folded. These sections of STICH et al. do not disclose or suggest, however, creating a perforation on a card, such as STICH et al.'s card 11.

For at least these additional reasons, Applicant submits that claim 28 is patentable over STICH et al.

Claim 29 depends from claim 28 is believed to be patentable over STICH et al. for at least the reasons given above with respect to claim 28.

Claims 1-4, 6, 11, 28, and 29 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KLURE. Applicant respectfully traverses this rejection.

With respect to claim 1, KLURE does not disclose a multipurpose calling card that includes a key ring portion. The Examiner appears to rely on Figs. 1-7 of KLURE for allegedly disclosing this feature (Office Action, pg. 9). Applicant submits that these figures do not disclose a multipurpose card that includes a key ring portion.

Similar to the STICH et al. reference described above, the Examiner appears to allege that KLURE's card 12 corresponds to the recited calling card portion of the multipurpose card recited in claim 1 and the packaging 10 corresponds to the recited key ring portion. This is evident from the fact that KLURE does not disclose or even suggest the card 12 having a calling card portion and a key ring portion. The packaging in KLURE does, however, include an opening (see Fig. 1).

With this interpretation in mind, Applicant submits that KLURE's packaging 10 would not be considered a key ring portion. The Examiner fails to explain why one

skilled in the art would have been motivated to put KLURE's packaging 10 on a key ring. Despite the Examiner's allegations, the mere fact that the packaging 10 includes a hole would not lead one skilled in the art to hang this packaging from a key ring. Nothing in the disclosure of KLURE supports the Examiner's allegation. Moreover, KLURE does not disclose or suggest that packaging 10 is part of a multipurpose card, as recited in claim 1.

Even assuming, for the sake of argument, that KLURE's packaging 10 could reasonably be construed to be a part of a multipurpose calling card, KLURE does not further disclose or suggest that the size of the multipurpose calling card is approximately the size of a conventional calling card. It is clear from Figs. 1-11 of KLURE that the packaging that surrounds the card 12 in KLURE is not approximately the size of a conventional calling card. The Examiner admitted this on pg. 9 of the Office Action and alleged that "it would have been obvious to one of ordinary skill in the art and a matter of design choice to customized the multi-purpose package or card to any desired size based on cost considerations since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955)". Applicant disagrees.

In Figs. 1-6, KLURE discloses packaging 10 being much larger than plastic data card 12. In Fig. 7, KLURE discloses packaging 310 that appears smaller than the packaging 10 illustrated in Figs. 1-6, but still much larger than plastic data card 12. KLURE does not disclose or suggest that packaging 10 or 310 is approximately the size

of a conventional calling card. The Examiner's conclusory statement that this feature is merely a "design choice" is unsubstantiated by the disclosure of KLURE and insufficient for establishing a *prima facie* case of obviousness.

Moreover, the Examiner's quote of the decision in *In re Rose*, 105 USPQ 237 (CCPA 1995), misses the point since Applicant's claim 1 does not recite the packaging for a multipurpose card being approximately the size of a conventional calling card, but rather that a multipurpose card that includes a calling card portion and a key ring portion is approximately the size of the a conventional calling card. The packaging in KLURE is not part of a multipurpose calling card.

For at least the foregoing reasons, Applicant submits that claim 1 is patentable over KLURE.

Since claims 2-4 and 6 depend from claim 1, these claims are patentable over KLURE for at least the reasons given above with respect to claim 1.

Claim 11 depends from claim 7. Applicant submits that claim 11 is patentable over KLURE for at least the reasons given above with respect to claim 7.

Claim 28 recites features similar to those described above with respect to claim 1. Therefore, Applicant submits that claim 28 is patentable over KLURE for at least the reasons given above with respect to claim 1. Moreover, this claim recites additional features not disclosed by KLURE.

For example, claim 28 recites creating a perforation in the card to create a first calling card portion and a second portion. KLURE does not disclose or suggest this feature. The Examiner appears to rely on Figs. 1-7 of KLURE for allegedly disclosing

this feature. These figures of KLURE merely disclose that packaging 10 may include perforations around a card 12. KLURE does not disclose or suggest, however, creating a perforation on a card, such as KLURE's card 12.

For at least these additional reasons, Applicant submits that claim 28 is patentable over KLURE.

Claim 29 depends from claim 28 is believed to be patentable over KLURE for at least the reasons given above with respect to claim 28.

Claims 1-4, 11, 28, and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over KIM. Applicant respectfully traverses this rejection.

With respect to claim 1, KIM does not disclose a multipurpose calling card that includes a key ring portion. The Examiner relied on col. 3, lines 36-38 of KIM for allegedly disclosing this feature (Office Action, pg. 10). Applicant submits that this section of KIM does not disclose a multipurpose card that includes a key ring portion.

Col., 3, lines 36-38, of KIM discloses a postcard 11 including a hole 14 "for hanging the frontal view of the postcard." This section of KIM does not disclose or suggest that hole 14 is for hanging from a key ring. Moreover, the Examiner fails to explain why one would seek to hang KIM's postcard 11 from a key ring since such an act is not customarily performed. Despite the Examiner's allegations, the mere fact that the postcard 11 includes a hole 14 would not lead one skilled in the art to hang this postcard from a key ring. Nothing in the disclosure of KIM supports the Examiner's allegation.

Even assuming, for the sake of argument, that KIM's postcard 11 could reasonably be construed to be a part of a multipurpose calling card, KIM does not further

disclose or suggest that the size of the multipurpose calling card is approximately the size of a conventional calling card. The Examiner admitted this on pg. 10 of the Office Action and alleged that "Kim fails to put a restriction on the size of the multipurpose calling and the possibility of the multi-purpose calling card being the size of a conventional calling card is not restricted." Applicant disagrees with the Examiner's position.

KIM in no way discloses or suggests that postcard 11 and attached calling card 12 is the size of a conventional calling card. In fact, KIM specifically discloses that calling card 12 has dimensions well-known in the art (col. 3, lines 45-50). Therefore, it would seem impossible for KIM's postcard 11 and calling card 12 combination to be the size of a conventional calling card when KIM specifically discloses that the calling card 12 is the size of a conventional calling card. The Examiner's assertion that the disclosure of KIM does not put a restriction on the size of the postcard 11/calling card 12 combination does not render this features obvious and is insufficient for establishing a *prima facie* case of obviousness.

Further with respect to this feature, the Examiner alleged that "it would have been obvious to one of ordinary skill in the art and a matter of design choice to customized the multi-purpose package or card to any desired size based on cost considerations since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955)" (Office Action, pg. 10). Applicant disagrees.

The Examiner's conclusory statement that this feature is merely a "design choice" is unsubstantiated by the disclosure of KIM and insufficient for establishing a *prima facie* case of obviousness. Moreover, the Examiner's quote of the decision in *In re Rose*, 105 USPQ 237 (CCPA 1995), misses the point since the disclosure of KIM, as set forth in detail above, specifically teaches away from providing a multipurpose card that is approximately the size of a conventional calling card.

For at least the foregoing reasons, Applicant submits that claim 1 is patentable over KIM.

Since claims 2-4 depend from claim 1, these claims are patentable over KIM for at least the reasons given above with respect to claim 1.

Claim 11 depends from claim 7. Applicant submits that claim 11 is patentable over KIM for at least the reasons given above with respect to claim 7.

Claim 28 recites features similar to those described above with respect to claim 1. Therefore, Applicant submits that claim 28 is patentable over KIM for at least the reasons given above with respect to claim 1.

Claim 29 depends from claim 28 is believed to be patentable over KIM for at least the reasons given above with respect to claim 28.

Claims 1-4 and 6 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOLSTROM in view of STICH et al. or KIM or KLURE or TASKETT. Applicant respectfully traverses this rejection.

At the outset, Applicant submits that the Examiner failed to make a proper rejection of claims 1-4 and 6 under 35 U.S.C. § 103(a) based on HOLSTROM and

STICH et al., HOLSTROM and KIM, and HOLSTROM and KLURE. A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner set forth in the Office action (1) the relevant teachings of the prior art reference(s) relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See M.P.E.P. § 706.02(j). The Examiner failed to point to any section of STICH et al., KIM, or KLURE in the rejection of claims 1-4 and 6 based on HOLSTROM and STICH et al., HOLSTROM and KIM, and HOLSTROM and KLURE. In fact, the Examiner did not address these secondary references. Accordingly, the rejection of claims 1-4 and 6 under 35 U.S.C. § 103(a) based on HOLSTROM and STICH et al., HOLSTROM and KIM, and HOLSTROM and KLURE is improper.

HOLSTROM is directed to a lost article tracking system (Abstract).

TASKETT is directed to a refundable prepaid telephone card (Abstract).

Applicant submits that HOLSTROM and TASKETT do not disclose or suggest the combination of features recited in Applicant's claim 1. For example, HOLSTROM and TASKETT do not disclose a multipurpose card that includes a calling card portion and a key ring portion.

The Examiner appears to rely on Fig. 2 of HOLSTROM for allegedly disclosing these features. Fig. 2 of HOLSTROM illustrates a back view of a two-piece detachable

card. The card includes a base portion 10 and a tag portion 12 that can be attached to a key ring (as illustrated in HOLSTROM's Fig. 3) for item recovery purposes (col. 1, lines 5-7). If the keys to which tag portion 12 are lost, a person finding the keys can call the telephone number listed on the tag 12 and leave a message for the owner of the keys as to where the keys may be retrieved (col. 3, lines 9-21). The owner may call the telephone number listed on the base portion 10 in order to retrieve the voicemail message and, subsequently the keys (col. 3, lines 22-30).

HOLSTROM does not disclose or even suggest that base portion 10 is a calling card portion. In fact, the disclosure of HOLSTROM is in no way related to calling cards. The Examiner appears to rely on TASKETT for disclosing a prepaid telephone card with perforations (Office Action, pg. 12). Applicant submits that the disclosure of TASKETT does not remedy the deficiencies set forth above with respect to the disclosure of HOLSTROM. That is, TASKETT does not disclose or suggest a multipurpose card that includes a calling card portion and a key ring portion.

For at least the foregoing reasons, Applicant submits that claim 1 is patentable over HOLSTROM in view of STICH et al. or KIM or KLURE or TASKETT.

Since claims 2-4 and 6 depend from claim 1, these claims are patentable over HOLSTROM in view of STICH et al. or KIM or KLURE or TASKETT for at least the reasons given above with respect to claim 1.

Claims 13, 14, and 21 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KIM or STICH et al. in view of FONSECA ('977). Applicant respectfully traverses this rejection.

Claims 13 and 14 depend from claim 7. Applicant submits that the disclosure of FONSECA ('977) does not remedy the deficiencies set forth above regarding claim 7 with respect to the disclosures of KIM and STICH et al. Therefore, Applicant submits that claims 13 and 14 are patentable over KIM and FONSECA ('977) and STICH et al. and FONSECA ('977) for at least the reasons given above with respect to claim 7.

Claim 21 depends from claim 16. Applicant submits that the disclosure of FONSECA ('977) does not remedy the deficiencies set forth above regarding claim 16 with respect to the disclosures of KIM and STICH et al. Therefore, Applicant submits that claim 21 is patentable over KIM and FONSECA ('977) and STICH et al. and FONSECA ('977) for at least the reasons given above with respect to claim 16.

Claims 15 and 25-27 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KIM or KLURE or STICH et al. in view of FONSECA ('447) or SMALL or SMALL in view of KLURE or KIM or STICH et al. Applicant respectfully traverses these rejections.

Claim 15 recites means for creating at least one multipurpose card that includes a main portion and a keytag portion, where the keytag portion is separable from the main portion, and means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information specified by a user. The combinations of KIM and FONSECA ('447), KIM and SMALL, KLURE and FONSECA ('447), KLURE and SMALL, STICH et al. and FONSECA ('447), STICH et al. and SMALL, SMALL and KLURE, SMALL and KIM, and SMALL and STICH et al. do not disclose or suggest the features of Applicant's claim 15.

For example, the combinations of KIM and FONSECA ('447), KIM and SMALL, KLURE and FONSECA ('447), KLURE and SMALL, STICH et al. and FONSECA ('447), STICH et al. and SMALL, SMALL and KLURE, SMALL and KIM, and SMALL and STICH et al. do not disclose or suggest means for creating at least one multipurpose card, where the at least one multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion. As set forth above, KIM, KLURE, and STICH et al. do not disclose or suggest a multipurpose card having a main portion and a keytag portion, as that term is commonly used in the art. FONSECA ('447) and SMALL also fail to disclose this feature.

For at least the foregoing reasons, Applicant submits that claim 15 is patentable over KIM and FONSECA ('447), KIM and SMALL, KLURE and FONSECA ('447), KLURE and SMALL, STICH et al. and FONSECA ('447), STICH et al. and SMALL, SMALL and KLURE, SMALL and KIM, and SMALL and STICH et al.

Independent claim 25 recites features similar to those set forth above with respect to claim 15. Therefore, Applicant submits that claim 25 is patentable over KIM and FONSECA ('447), KIM and SMALL, KLURE and FONSECA ('447), KLURE and SMALL, STICH et al. and FONSECA ('447), STICH et al. and SMALL, SMALL and KLURE, SMALL and KIM, and SMALL and STICH et al. for at least the reasons given above with respect to claim 15.

Claims 26 and 27 depend from claim 25. Therefore, Applicant submits that these claims are patentable over KIM and FONSECA ('447), KIM and SMALL, KLURE and FONSECA ('447), KLURE and SMALL, STICH et al. and FONSECA ('447), STICH et

al. and SMALL, SMALL and KLURE, SMALL and KIM, and SMALL and STICH et al.
for at least the reasons given above with respect to claim 25.

Claim 30 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KIM or KLURE or STICH et al. in view of RAMING or MACWILLIAMS et al. or BISHOP. Applicant respectfully traverses these rejections.

Claim 30 depends from claim 28. Applicant submits that the disclosures of RAMING, MACWILLIAMS et al., and BISHOP do not remedy the deficiencies set forth above regarding claim 28 with respect to the disclosures of KIM, KLURE, and STICH et al. For example, RAMING, MACWILLIAMS et al., and BISHOP do not disclose generating a card that is substantially the size of a conventional calling card, creating a perforation to create a first calling card portion and a second portion, and forming a hole in the second portion. Moreover, this claim is patentable over the combinations of KIM and RAMING, KIM and MACWILLIAMS et al., KIM and BISHOP, KLURE and RAMING, KLURE and MACWILLIAMS et al., KLURE and BISHOP, STICH et al. and RAMING, STICH et al. and MACWILLIAMS et al., and STICH et al. and BISHOP for reasons of its own.

Claim 30 recites placing a label on the perforation. The Examiner admitted that KIM, KLURE, and STICH et al. do not disclose this feature (Office Action, pg. 14). The Examiner relied on the figures of RAMING, Figs. 1 and 2 of BISHOP, and Figs. 1-7 and col. 3, lines 18-34, of MACWILLIAMS et al. for allegedly disclosing placing a label on the perforation. Applicant submits that these references do not disclose or suggest the recited feature.

RAMING discloses a duplex carton label/packing list. Figs. 3, 5-8, and 10 of RAMING illustrate a form 20 that includes a perforation and labeling next to the perforation that instructs a user as to how to remove an address label from form 20. These figures do not disclose or suggest, however, the labeling being located on the perforation, as recited in Applicant's claim 30, but merely next to the perforation.

Similar comments can be made for BISHOP. BISHOP does not disclose or suggest placing a label on a perforation.

MACWILLIAMS et al. appears to disclose a label 101 that is located on a perforation 111 (Fig. 1). With respect to motivation, the Examiner alleged that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this teaching into that of the primary references as means of guiding a user on how to tear or separate two portions of an article or providing a label converging the two-piece perforated piece" (Office Action, pg. 14). KIM, KLURE, and STICH et al. do not disclose or suggest a desire to place a label on a perforation. Moreover, MACWILLIAMS et al. does not disclose or suggest a desire to place a label on a perforation of a card that includes a first calling card portion and a second portion. Applicant submits that the Examiner's motivation has been impermissibly gleaned from Applicant's own disclosure.

For at least these additional reasons, Applicant submits that claim 30 is patentable over KIM and RAMING, KIM and MACWILLIAMS et al., KIM and BISHOP, KLURE and RAMING, KLURE and MACWILLIAMS et al., KLURE and BISHOP, STICH et al. and RAMING, STICH et al. and MACWILLIAMS et al., and STICH et al. and BISHOP.

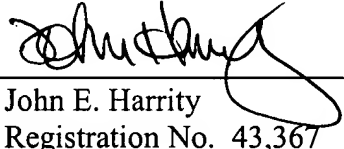
In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectively submitted,

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